

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Anand SUBRAMANIAN, et al.

Confirmation No. 4306

Application No.: 10/001,772

Art Unit: 3622

Filed: October 31, 2001

Examiner: Raquel Alvarez

For: INTERNET CONTEXTUAL
ADVERTISEMENT DELIVERY SYSTEM
AND METHOD

APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. § 41.41

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants submit this reply brief in accordance with 37 C.F.R. § 41.41 in response to the Examiner's Answer mailed July 19, 2007.

REMARKS

Claims 15, 21, 22 and 27-89 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,076,443 to Emens et al. ("Emens") in view of U.S. Patent No. 5,835,087 to Herz et al. ("Herz").

In her Answer, the Examiner sets forth those elements of claim 15 which she finds to be disclosed in Emens. Conspicuously, she fails to recite from the preamble that the claim is directed to a "system delivering ads to a user *viewing content* operating a station..." This is because the Emens system is incapable of displaying an advertisement and content at the same time. In

addressing the limitation which requires that the system include “a data store *containing a set of relevancy rules* associated with each ad,” she fails to even allege that the structure in Emens has the relevancy rules in the data store.

Similarly the Examiner asserts that Emens disclose “a match maker that accesses the content retrieved by the user.” However, the claim calls for “a match maker *configured to, in response to the submission of a URL by the user at the operating station,* access [] the content retrieved by the user.” Emens does not access content in response to a URL.

The Examiner contends that Emens discloses that “the search result item is displayed along with the matching product icon.” The Examiner relies on Emens, column 7, lines 11-17, and in support of her contention states that the “product icon is a targeted advertisement based on the search result.” *See* Examiner’s Answer, Response to Argument, page 5.

Appellant respectfully submits that Emens neither discloses nor suggests that the product icon is a targeted advertisement, as contended by the Examiner. In fact, there is no indication in Emens that the product icon even identifies a particular product. It is merely a link to an advertisement. Further, Emens fails to disclose, or suggest, displaying the requested content and the targeted ad together. Indeed, Emens discloses that either the requested information or the ad be shown. Emens further makes it clear that the ad should be shown only if the user specifically asks for it:

The search engine then returns a specific search result set showing items which may contain the sought after information. For each search result item, a graphical user interface (GUI) selection is presented, allowing the user to select the GUI, on demand if so desired, to investigate related advertisement. Emens, Col. 4, line 65 thru Col. 5, line 3 (emphasis added).

However, claim 15 of the claimed invention is directed to a system for delivering ads which includes a matchmaker configured to “**directly send the targeted ad to the station for display with the content**” as a result of the match maker and “in response to the submission of a URL by

the user at the operating station.” Simply stated an icon is NOT an ad, and in Emens the only way to get an ad is to click on the icon, it is not delivered merely by submission of a URL.

Independent claim 89 recites similar subject matter. Independent method claim 21 recites the step of “displaying the targeted ads at the station with the content.” Clearly Emens contemplates a user making a selection from the displayed search results to “investigate related advertisement[s].” Accordingly, Emens does not disclose sending the targeted ad and the content to be displayed together, as required in the independent claims.

It should be clear that the independent claims are conditioned by reciting “in response to the submission of a URL.” On page 6, the Examiner addresses this feature by contending that “[m]odifying Emens to incorporate Herz[‘s] teachings will produce a system wherein the user uses the URL instead of keywords to receive the content.” First, Appellant notes that eliminating keywords from Emens’ system would frustrate and negate the purpose of providing a search engine. Thus, the Examiner’s approach is improper. Second, Herz, does not disclose inputting a URL to receive content. In Herz, the system has a set of user profiles. When the system receives new documents, e.g., an advertisement, it checks the content against the user profile and will on its own, send the user notice that it has content the user may be interested in. In effect, Herz is a push system that sends out information to the user without a request.. Emens requires a user to initiate a search query, i.e., Emens incorporates a “search engine performing an Internet search” to obtain search results for display. *See* Emens, column 4, lines 54-58; and Appellant’s Second Brief on Appeal, page 8. As a result, it would not be possible to combine Emens and Herz as suggested by the Examiner.

Further, even if you could combine Herz and Emens, Appellants contend that combining Emens and Herz does not result in the claimed invention. Together, Emens and Herz must either (1) accept a user’s query triggering a search engine to search the Internet, with the results being sent to a product matching manager to match the search result items to a product icon (as required by Emens’ system); or (2) determine the relevancy of an advertisement based on its own content in comparison to a user’s profile to develop a list of relevant ads to be sent to the user for possible

reading (as required by Herz's disclosure). In neither case is a match of an advertisement being made on the basis of content obtained based on submission of a URL.

The Examiner also contends that Appellants have attempted to show non-obviousness by attacking the references individually. Appellants respectfully disagree. To show the erroneous combination being proffered by the Examiner, the Appellants have described what is disclosed by the Emens and Herz references. However, Appellants repeatedly state that it is Emens and Herz in combination that fails to disclose, or suggest, the claimed invention.

Appellants submit that their Second Brief on Appeal, filed on June 11, 2007, fully addresses all of the grounds for rejection, and respectfully draws the Board's attention to that document for a full analysis of the errors in the Examiner's rejection.

CONCLUSION

For the reasons set forth above and detailed in Appellants' Second Brief on Appeal, the rejections of claims 15, 21, 22 and 27-89 should be reversed. Appellants respectfully request that the application be remanded to the Primary Examiner with an instruction to withdraw the 35 U.S.C. § 103(a) rejections, and pass the case to allowance.

Favorable consideration of this Reply Brief is respectfully requested.

If any fees or charges are required in connection with the above-identified matter, authorization is hereby provided to charge our U.S. Patent and Trademark Office Deposit Account No. 04-0100.

Dated: September 17, 2007

Respectfully submitted,



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